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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREA HUGHS-BAIRD and
BRIAN D. SWIFT

Appeal 2009-004914
Application 10/086,014
Technology Center 3600

Decided: December 17, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Andrea Hughs-Baird and Brian D. Swift (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-5, 8, 18, and 20, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION[1]

We AFFIRM.

THE INVENTION

The Appellants invented a gaming device having an improved offer and acceptance game (Specification 2:24-25).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A gaming device comprising:

[1] a game including:

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed July 20, 2007) and the Reply Brief ("Reply Br.," filed November 13, 2008), and the Examiner's Answer ("Ans.," mailed September 17, 2008), and Final Rejection ("Final Rej.," mailed October 13, 2006).

(i) a plurality of offers, wherein said plurality of offers are payable to a player, and

(ii) a plurality of player selectable masked selections;

[2] a display device;

[3] an input device;

[4] a memory device storing a plurality of instructions; and

[5] a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:

(a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,

(b) enable the player to select one of said selections,

(c) reveal the offer directly and individually associated with the selected selection to the player,

(d) enable the player to accept or reject the revealed offer,

(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and

(f) if the player accepts said revealed offer, pay said revealed offer to the player.

THE REJECTIONS[2]

The Examiner relies upon the following prior art:

Baerlocher et al. US 6,648,754 B2 Nov. 18, 2003

Claims 1-5, 8, 18, and 20 stand rejected under 35 U.S.C. § 102(e) as anticipated by Baerlocher.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher. This pertinent issue turns on whether Baerlocher describes that input selections and offers are directly and individually associated.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Baerlocher

01. Baerlocher is directed to a gaming device having and offer and acceptance game with a termination limit (Baerlocher 1:61-63).

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[2] The Examiner's previously asserted 35 U.S.C. § 112, first paragraph, rejection has been withdrawn (Ans. 3).

02. Baerlocher describes a game where a player selects a first input from a plurality of inputs (Baerlocher 9:9-13). The inputs are associated with a number of steps (Baerlocher 9:9-11). The steps are a numerical value from one up to the termination limit, such as twenty-five (Fig. 4A and 4B). The steps are associated with an offer and the offer is presented to the player after selecting an input (Baerlocher 9:11-13). The player can either accept the offer and the game terminates or the player can reject the offer and select second input (Baerlocher 6:51-53 and 9:15-19). The steps associated with second input are summed with the steps associated with first input (Baerlocher 9:15-19). The offer associated with the summed steps is presented the player (Baerlocher 9:15-22). These steps are repeated until player exceeds a termination limit of twenty-five steps or when the player accepts the offer (Baerlocher 6:51-53 and 9:22-27).

03. The game can also be configured such that the player can pick the same input selections two or more times and can further be configured such that the same number of steps to be generated whether or not the player picks the same input selections a plurality of time (Baerlocher 10:39-44). The game can further reshuffle or redistribute the numbers of step numbers associated with the input selections after each offer and thereby provide a new order of steps associated to all of the input selections (Baerlocher 10:35-39).

04. When a player selects an input selection, the game reveals the accrued steps and further displays the initial offer in the current offer display (Baerlocher 9:38-49).

Facts Related To The Level Of Skill In The Art

05. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of gaming systems and devices. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969);

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,

1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). S*ee also Tex. Digital,* 308 F.3d 1200, 1204-05.

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d

1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

ANALYSIS

Claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher

The Appellants first contend that (1) Baerlocher does not directly or individually associate offers with the selections such that each offer is directly and individually associated with a separate one of the selections, as required by limitation [5](a) of claim 1 (App. Br. 21-22 and 25-28). We disagree with the Appellants. The Appellants contest the Examiner's construction of limitation [5] (a) (Reply Br. 12-14 and Ans. 12-16) and therefore we must construe this limitation under the broadest reasonable interpretation. Limitation [5] (a) requires a direct and individual association between an input selection and an offer. The Appellants are correct in their assertion that the plain meaning for the term "directly", that is consistent with their usage in the specification and the claims, is to be without intervening or altering steps (Reply Br. 12-13). Under the broadest reasonable interpretation, there must be a relationship between the offer value and the input selection that will not be affected by other factors. The plain and ordinary meaning of the term "individually" is a separate and distinct element. As such, limitation [5] (a) requires that the relationship between an input selection and an offer is independent of any other relationship between other input selections and offers. The claim language

does not impose any further limitations on the direct and individual relationship between the input selection and the offer value.

Baerlocher describes that a user selects an input device that is associated to a step number and the step number is associated with an offer (FF 02). For example, a player can select the first of a plurality of buttons and that selected button is associated with the step number 5. Step number five is further associated with an offer of 20. That is, there is a direct relationship between the input selection and the offer. The value of the offer is directly dependant on the input selected by the player. Additionally, the connection starting from the input selection and ending with the offer value is an individual one. That is, the resulting steps and values are only associated with the specific input selection. Furthermore, we agree with the Appellants that each input selection results in a separate offer (Reply Br. 11). As such, Baerlocher describes limitation [5] (a).

The Appellants also contend that if the player rejects the offer, that offer is not directly and individually reassociated with one of the input devices (App. Br. 22). We disagree with the Appellants. Baerlocher explicitly describes that the game can reassociate the step numbers and offer values with the input selection thereby enabling a player to select the same selection multiple times (FF 03). The game further allows for the reshuffling or redistributing the step numbers to all of the input selections after a player has rejected an offer (FF 03). This reassociation is direct and individual for the reasons discussed *supra.* As such, Baerlocher explicitly describes this limitation.

The Appellants further contend that (2) Baerlocher fails to describe the feature of revealing the offer directly and individually associated with the selected selection to the player, as required by limitation [5](c) (App. Br. 23-24). We disagree with the Appellants. Baerlocher explicitly describes that the current offer is revealed and displayed for the player to view upon the player selecting an input selection. The input selection is directly and individually associated to the offer values for the reasons discussed *supra*. As such, Baerlocher describes limitation [5] (c).

The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher.

CONCLUSIONS OF LAW

The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-5, 8, 18, and 20 under 35 U.S.C. § 102(e) as anticipated by Baerlocher is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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